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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/850,114	05/08/2001	Takashi Takenaga	Q64130	9597

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EXAMINER

BAYARD, DJENANE M

ART UNIT	PAPER NUMBER
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2141

DATE MAILED: 01/04/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/850,114

Applicant(s)

TAKENAGA, TAKASHI

Examiner

Djenane M Bayard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 15 November 2004.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-13 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-13 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Response to Arguments

1. This is response to amendment filed Applicant's arguments filed 11/5/04 have been fully considered but they are not persuasive. Therefore, this case is made Final.
2. Claims 1-11 stand as stated in the previous office action. As per new claims 12 and 13, the prior art of U.S. Patent No. 6,505,203 to Adler has been introduced to teach the limitation.
3. As per claims 1 and 7, Applicant argues that the prior arts of record failed to teach "the inclusion of the advertisement is in no way based on area or location of either the recipient or sender of the e-mail." However, claim 1 fails to teach such limitation. Furthermore, Applicant submits that there is no teaching or suggestion in Gough to include advertisements based on geographic or area information. However, claim 1 and all the subsequent claims fails to teach such limitation. Applicant's claimed invention as understood by the Office is a system for incorporating ad information into e-mails comprising an area information detecting means for detecting whether an e-mail transmitted from the sending terminal contains area information. Therefore, area information is not geographical. Applicant is requested to submit further clarification as the definition of "area information".

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

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(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1-5, 7-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0063723 to Hirono in view of U.S. Patent No. 6,360,221 to Gough et al.

a. As per claims 1 and 7, Hirono teaches an area information detector for detecting whether information transmitted from the sending terminal contains area information or not (See page 5, paragraph [0078]); a position information database that stores position information indicating the display range of area information displayed (See page 3, paragraph [0049]); an ad information database where ad information containing ad data and position data of the ad provider is stored; and ad information inserting section for retrieving position information on the area information from said position information database when it is detected that the e-mail contains area information by said area information detector, retrieving ad information positioned in the display range of area information indicated by the retrieved position information from said ad information database based on the position data of ad information, and inserting ad data contained in the retrieved ad information (See page 4, paragraph [0052-0053]). However, Hirono fails to teach a system for incorporating ad information into e-mails, comprising: at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal;

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Gough et al teaches a system for incorporating ad information into e-mails, comprising: at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal (See col. 4, lines 1-21 and col. 6, lines 12-39);

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate a system for incorporating ad information into e-mails, comprising: at an e-mail site including an e-mail server for saving an e-mail transmitted from a sending terminal and transmitting the e-mail to a receiving terminal based on a transmission request made by the receiving terminal as taught by Gough et al in the claimed invention of Hirono et al in order to provide free e-mail services for member (See col. 2, lines 1-6).

b. As per claim 2, Hirono teaches incorporating ad information into e-mails wherein said area information is display of a map, traffic facilities and/or an address (See page 2, paragraph [0019]).

c. As per claims 3 and 8, Hirono teaches wherein position information stored in the position information database specifies the display range of area information by latitude and longitude (See page 3, paragraph [0049]).

d. As per claim 4, Hirono teaches the claimed invention as described above.

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However, Hirono fails to teach wherein ad data contained in the ad information stored in said ad information database is banner ad information.

Gough et al teaches wherein ad data contained in the ad information stored in said ad information database is banner ad information col. 6, lines 12-39);

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate wherein ad data contained in the ad information stored in said ad information database is banner ad information as taught by Gough et al in the claimed invention of Hirono et al in order to provide free e-mail services for member (See col. 2, lines 1-6).

e. As per claims 5 and 9, Hirono et al teaches wherein position data contained in the ad information stored in said ad information database specifies the position of an ad provider by latitude and longitude (See page 4, paragraph [0053]).

f. As per claim 10 Hirono teaches the claimed invention as described above. However, Hirono fails to teach inserting said ad data into an e-mail transmitted from a sending terminal before saving the e-mail or before transmitting the e-mail to a destination e-mail server.

Gough et al teaches inserting said ad data into an e-mail transmitted from a sending terminal before saving the e-mail or before transmitting the e-mail to a destination e-mail server (See col. 8, lines 16-31).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate inserting said ad data into an e-mail transmitted from a sending

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terminal before saving the e-mail or before transmitting the e-mail to a destination e-mail server as taught by Gough et al in the claimed invention of Hirono in order to provide free e-mail services for member (See col. 2, lines 1-6).

6. Claims 6 and 11 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0063723 to Hirono in view of U.S. Patent No. 6,360,221 to Gough et al as applied to claim 1 above, and further in view of U.S. Patent No. 6,684,088 to Halahmi.

a. As per claims 6 and 11, Hirono in view of Gough teaches the claimed invention as described above. Hirono teaches a display format detector for detecting the area information display format of an e-mail at a receiving terminal as the source of an e-mail transmission request when an e-mail transmission request is made by the receiving terminal or when the e-mail is transmitted to a destination e-mail server (See page 5, paragraph [0078]); However, Hirono fails to teach and a display format converter for converting the display format of the area information in the e-mail to be transmitted to the receiving terminal to the display format of the receiving terminal when it is detected that the display format of the receiving terminal differs from the display format of the area information in the e-mail transmitted from the sending terminal.

Halahmi teaches and a display format converter for converting the display format of the area information in the e-mail to be transmitted to the receiving terminal to the display format of the receiving terminal when it is detected that the display format of the

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receiving terminal differs from the display format of the area information in the e-mail transmitted from the sending terminal (See col. 4, lines 49-60).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate and a display format converter for converting the display format of the area information in the e-mail to be transmitted to the receiving terminal to the display format of the receiving terminal when it is detected that the display format of the receiving terminal differs from the display format of the area information in the e-mail transmitted from the sending terminal as taught by Halahmi in the claimed invention of Hirono in view of Gough et al in order for the e-mail message to be suitable for display by a low bandwidth device (See col. 4, lines 49-60).

7. Claims 12 and 13 are rejected under 35 U.S.C. 103(a) as being unpatentable over U.S. Patent Application No. 2002/0063723 to Hirono in view of U.S. Patent No. 6,360,221 to Gough et al as applied to claim 1 above, and further in view of U.S. Patent No. 6,505,203 to Adler.

a. As per claims 12 and 13, Hirono in view of Gough et al teaches the claimed invention as described above. However, Hirono in view of Gough et al fails to teach incorporating ad information into e-mails wherein the area information corresponds to an area of the receiving terminal.

Adler teaches a geographically sensitive automated notice system. Furthermore, Adler teach incorporating ad information into e-mails wherein the area information

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corresponds to an area of the receiving terminal (See col. 3, lines 57-67 and col. 4, lines 1-3).

It would have been obvious to one with ordinary skill in the art at the time the invention was made to incorporate ad information into e-mails wherein the area information corresponds to an area of the receiving terminal as taught by Hirono in view of Gough et al in order to provide a mechanism for distribution of an electronic mail alert notification to all within the computed area (See col. 3, lines 43-46).

Conclusion

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

J.P. Patent publication No. 11-259390 to Toshiaki et al teaches a system and method for transmitting electronic mail with which transmission information containing map information can be easily prepared as mail information and this information can be transmitted as electronic mail.

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

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advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

10. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Djenane M Bayard whose telephone number is (571) 272-3878. The examiner can normally be reached on Monday- Friday 5:30 AM- 3:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Rupal Dharia can be reached on (571) 272-3880. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Djenane Bayard


RUPAL DHARIA
SUPERVISORY PATENT EXAMINER